

REMARKS

Claims 1-16 and 30-38 have been examined. Claim 1 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claims 1-16 and 30-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buchanan, et al.* (U.S. Pat. No. 7,216,106) in view of *Anderson, et al.* (U.S. Pat. Publ. No. 2001/0018739). Claims 1, 3, 6, 9, and 11 have been amended. No new matter has been added through these amendments. No claims have been canceled or added. Hence, after entry of this Amendment, claims 1-16 and 30-38 stand pending for examination.

Rejections Under 35 U.S.C. § 101

The Federal Circuit recently clarified the standard for assessing compliance with §101, confirming that a “claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, ____ F.3d ___, ___, 2007-1130 at 21 (Fed. Cir. 2008)(emphasis maintained).

Claims 1, 3, 6, 9, and 11 have been amended to emphasize a tie to a particular machine by reciting the involvement of a computer. It is thus believed that independent Claim 1 is properly directed to patentable subject matter, as are the various claims that depend therefrom. Further, amended claims 3, 6, 9, and 11 are also believed to be properly directed to patentable subject matter. For at least this reason, Applicants respectfully request withdrawal of the §101 rejection of claims 1-16.

Rejections Under 35 U.S.C. § 103(a)

The rejections under §103 are respectfully traversed. Claim 1 recites a method comprising: “receiving an electronic package defining an image of the financial instrument at a first institution from a presenter, the image having been generated as part of a transaction at a point of sale....” Claims 30 and 34 contain similar recitations. The Office Action cites to

Anderson's background section for teaching or suggesting this recitation. Office Action, page 4, citing Anderson, ¶¶39-43. Anderson does not teach or suggest this recitation.

While Anderson discusses check imaging and point-of-sale devices separately, the two topics are not interrelated. The invention of Anderson is directed towards a computer-based method for creating signed electronic documents, using a markup language in which separate blocks of a document are parsed out based on the logical fields contained therein. Anderson, ¶¶58, 59. The cited paragraphs of Anderson only list "several mechanisms for using electronic communication to substitute for paper flow in financial transactions." Id., at ¶38. Specifically, paragraph 42 of Anderson is a basic definition of ATM and point-of-sale devices:

[0042] Automatic teller machines (ATM) and point of sale (POS) devices allow an individual to conduct a transaction from a location outside the home. ATMs have remote computer terminals connected to the user's bank which allow access, directly or indirectly through switching networks, to the user's account in the central computer of the bank. Similarly, POS devices are remote computer terminals located at a place of business which allow access to an individual's account information stored in a computer within a network of financial institutions, to permit transfer of funds from the user's account to the merchant's account at another bank.

Similarly, paragraph 43 of Anderson is a basic definition of check imaging:

[0043] Check imaging, another electronic transaction procedure, involves the scanning of a paper check by a scanner, which digitizes the image of the check pixel by pixel and stores the image electronically in a memory. The image may then be transferred electronically to substitute for or precede the physical delivery of the check, e.g., to truncate the clearing process. The image of the check may be recreated on a computer monitor or on paper for verification by the appropriate banking institutions.

Emphasis added.

The point-of-sale devices and check imaging procedure of paragraphs 42 and 43 are two mechanisms for electronic communication of financial transactions. However, these devices and procedures are not interrelated by Anderson. In contrast, the recitation of claim 1 specifically calls for: “the image having been *generated* as part of a *transaction at a point of sale....*” Emphasis added. At no point does Anderson teach or suggest an image of a financial instrument being *generated in a transaction at a point-of-sale.*

For at least these reasons, each of claims 1, 30, and 34 are respectfully believed to be patentable over the cited art. Further, claims 2-16, 31-33, and 35-38 depend, either directly or indirectly, on claims 1, 30, and 34, and are believed to be patentable over the cited art at least by virtue of their dependence on an allowable base claim.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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